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Amendment in Response to March 17, 2006 Office Action

REMARKS

The undersigned Attorney for Applicants thanks the Examiner for the helpful in-person interview held April 27, 2006. The amendments in this paper are consistent with those discussed at the interview and reflected in the Interview Summary Record.

In the March 17, 2006 office action, the Examiner objected to the drawings under 37 CFR 1.83(a) for not showing "every feature of the invention specified in the claims." In particular, the Examiner stated that the feature "the second sash of the claim 20 or the multi-task window of claim 28 is entirely receivable into the wall adjacent the window frame" must be shown or the feature canceled from the claim.

Also, the Examiner objected to claim 28, and asked that the word "that" in line 2 "should be changed to --and-- in order to clarify that the tap ('tab') rather than the window protrudes into the frame."

Claims 20, 28 and 29 were rejected under 35 USC 112, 1st ¶. Specifically, the Examiner stated that the original disclosure does not contain sufficient information regarding the claimed feature "the second sash of claim 20 or the multi-task window of claim 28 is entirely receivable into the wall adjacent the window frame." (Emphasis original).

Claims 2, 8, 12 and 19-31 were rejected under 35 USC 103(a) as being unpatentable over Mitchell (USP 3,896,589) in view of McManigal (USP 5,253,051). Claims 2, 8, 12 and 19-31 were also rejected under 35 USC 103(a) as being unpatentable over Portwood (USP 3,861,444) in view of McManigal (USP 5,253,051).

Amendments to the Claims

As agreed at the Interview, dependent Claims 20 and 28 have been amended to change the language that "the (sash/window) is entirely (received/receivable)" to "most, but not all, of the (sash/window) is (received/receivable)."

Also in dependent Claim 28, the word "that" has been changed to --and--, as requested by the Examiner in the Office Action.

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Independent Claim 21 has been amended to recite that the 'multi-task window' is: (1) slidably mounted in the window frame; and (2) is capable of being moved along a horizontal window unit axis until at least a portion of it extends beyond the frame perimeter. Claim 21 has further been amended to change the verb "housing" to the verb --comprises-- for clarity.

OBJECTIONS TO THE DRAWINGS

As stated in the Interview Summary, the Examiner agreed to withdraw the drawing objections to claims 20 and 28, if these two claims were amended in the manner suggested by the Examiner. Since this has been done, the drawing objections have been overcome.

OBJECTIONS TO THE CLAIMS

Claim 28 has been amended in the manner suggested by the Examiner, and so this objection is believed to be overcome.

REJECTION OF THE CLAIMS UNDER 35 USC 112, 1ST ¶

As stated in the Interview Summary, the Examiner agreed to withdraw the 112, 1 rejection of claims 20 and 28 if these two claims were amended in the manner suggested by the Examiner. Since this has been done, the 112, 1, rejections have been overcome.

As acknowledged by the Examiner at the Interview, the original application provides an adequate written description, and enables one skilled in the art to practice the claimed invention without undue experimentation, for all pending claims, as amended herein.

REJECTION OVER THE PRIOR ART**A. Rejection of the Claims Under 35 U.S.C. §103(a) as being unpatentable over Mitchell in view of McManigal**

In the Office Action, claims 2, 8, 12 and 19-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over USP 3,896,589 ("Mitchell") in view of USP 5,253,051 ("McManigal").

This rejection is traversed for two reasons: (1) one of ordinary skill in the art would not modify Mitchell as taught by McManigal, and (2) even if one were to combine the two

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references, one still would not arrive at the inventions of either independent claim 19 or independent claim 21.

(1) One of ordinary skill in the art would not modify Mitchell as taught by McManigal

The Examiner's argument more or less is that it would be obvious to start with Mitchell's teaching of a window unit having two sash windows that are slidable within a window frame, and modify one of the two to include an artificial display, as taught by McManigal. It is submitted that this is not at all obvious.

Mitchell is directed to a thermally improved window frame 10 having specifically formed jamb or stile members 15, 16. The window frame 10 accommodates horizontally sliding window sashes 12a, 12b. "As best illustrated in Fig. 2, the jamb members 15, 16 each comprise a side wall portion 17 which is sinuous in cross-section as defined by alternate, substantially rectangular projections 18a, 18b, directed outwardly of each side of and co-extensive with the length of the jamb members." (Col. 3, lines 16-21). As seen in Mitchell's Fig. 2, this side wall portion 17 is found on both the left and right sides of the frame 10. Importantly, the entire point of Mitchell is to provide the metal side wall portion 17 with a continuous sinuous path to help reduce heat flow between the inside and outside of the frame 10.

McManigal teaches the antithesis of a window. McManigal discloses an electronic display which is (1) mounted on an interior wall of a room, (2) framed to have the *appearance* of a window frame, (3) configured to receive signals comprising scenery; and (4) provided with a detector to locate a viewer in the room and change the scenery perspective accordingly. McManigal teaches nothing about mounting anything *in* an opening of a structure, let alone a window; McManigal only teaches hanging an artificial window *on* an interior wall or in the middle of a room.

The Examiner asserts that "it would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide a display module in the first or second window of Mitchell, in view of the teaching of the McManigal reference."¹

The Examiner's stated motivation for such a combination is that "this would provide the user to view simultaneously the outside scene and the selected scene presented on the video

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display, as recognized by one of ordinary skill in the art as taught by McManigal (col. 1, lines 40 through col. 2, line 29).²

However, this alleged motivation is illogical. If one had a window (such as in Mitchell) and could view the outside scene, they certainly would not turn to McManigal, which teaches what to do when no window is possible. In other words, McManigal's invention is only applicable when no window is present in the wall of a structure. Furthermore, since McManigal teaches using a camera to show the outside scene on a display, it would make no sense to provide Mitchell's window (through which one can *already* directly view the outside scene) with a display for viewing the same outside scene. If the Examiner were to disagree with this reasoning, the Examiner is kindly asked to explain why it would make sense to modify Mitchell's window to have McManigal's display and camera for showing the outside scene, when the outside scene is already visible through Mitchell's window.

In view of the foregoing, it is submitted that the Examiner's alleged motivation is without merit and purely comes from hindsight, upon viewing the present invention.

(2) Even if One Were to Modify Mitchell as taught by McManigal, One Still Would Not Arrive at the Invention of Independent Claims 19 and 21

Among its various features, independent Claim 19 requires the following:

"the second window being movable within the window frame and being receivable into the wall adjacent the window frame"; and

"wherein the second window includes a display capable of displaying an image from a display source."

Among its various features, independent Claim 21 requires the following:

"a multi-task window slidably mounted in the window frame";

"the multi-task window comprises a display module for receiving a display signal; and

¹ March 17, 2006 office action at page 6, lines 1-3.

² March 17, 2006 office action at page 6, lines 3-6.

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"the multi-task window is capable of being moved along a horizontal window unit axis until at least a portion of the multi-task window extends beyond the frame perimeter."

The combination of Mitchell and McManigal does not constitute a *prima facie* case of obviousness. In fact, the Examiner explicitly concedes that the combination of Mitchell and McManigal "still fails to teach the window being receivable into the wall adjacent the window frame (claim 19) or at least a portion of the window extending beyond the frame perimeter (claim 21)."³

Undeterred by this deficiency in his chosen combination of references, the Examiner takes "Official Notice" that "at least a portion of the window or the entire window extending beyond the frame perimeter or into the wall is well known and expected in the art."⁴ To support this "well known" fact, the Examiner points to such examples as "the operation of the vehicle window" or "the door or an elevator".⁵ The Examiner continues, however:

Further, the benefits of using at least a portion of the window or the entire window extending beyond the frame perimeter or into the wall to provide a full range of opening are well known and expected in the art. Therefore, it would have been obvious . . . to modify the Mitchell window capable of extending beyond the frame perimeter or entirely being received into the wall adjacent the frame, because this would provide a full range of opening.⁶ (emphasis added)

It is first submitted that the examples supporting the Examiner's "Official Notice", i.e., a "vehicle window" and "the door of an elevator" are completely inapposite. These examples are non-analogous art. One of ordinary skill in the art, faced with Mitchell's window, or even McManigal's artificial window with a display, is not likely to turn to vehicle windows or elevator doors for any reason whatsoever. Neither vehicle windows nor elevator doors customarily are equipped with displays, let alone displays that have to be moved out of the way so that one can see *through* the vehicle window or the elevator door.

³ March 17, 2006 office action at Page 6, lines 7-9.

⁴ March 17, 2006 office action at Page 6, lines 10-11.

⁵ March 17, 2006 office action at Page 6, lines 11-12.

⁶ March 17, 2006 office action at Page 6, lines 12-18.

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It is further submitted that the Examiner's apparent motivation for invoking "Official Notice" -- to "provide a full range of opening" (emphasis added), is inapplicable in the context of the present invention. Both a vehicle window and an elevator door may be opened to as to permit *passage* of objects (e.g., a hand or air, in the case of the vehicle window) or people (in the case of an elevator) from one side to the other. This has nothing to do with moving a sash having a display (claim 19) or a multi-task window (claim 21), so that one may look through the remaining sashes/window panes without obstruction. In any event, each of Mitchell's existing sashes 12a, 12b is *already* configured to be moved horizontally and thereby form an "opening", and so there is no need to make sash 12a or 12b either (a) receivable into the wall adjacent the window frame, or (b) capable of extending beyond the frame.

It is finally submitted that modifying Mitchell to permit its sash window to extend beyond the frame perimeter would render Mitchell unsatisfactory for its intended purpose. See MPEP § 2143.01. As discussed above, Mitchell provides the metal side wall portion 17 with a continuous sinuous path to help reduce heat flow between the inside and outside of the frame 10. Due to this continuous path established by the metal side wall portion 17, neither sash 12a, 12b can travel outside the frame 10, and thus cannot be receivable into the wall adjacent the window frame. In other words, Mitchell teaches away from allowing a sash (or "multi-task" window) to extend beyond the frame perimeter (as recited in pending Claim 21) to be receivable into the wall adjacent the window frame (as recited in pending Claim 19). Thus, the Examiner's suggestion that Mitchell be so modified would destroy the entire purpose of Mitchell, which is entirely contrary to the admonitions of MPEP § 2143.01. If the Examiner were to disagree with this reasoning, the Examiner is kindly asked to explain why it would make sense to modify Mitchell's window so as break the "continuous path", in view of Mitchell's teachings.

To summarize: (1) Mitchell's horizontally sliding window sashes 12a, 12b are limited by the sidewall portion 17 and so neither of them can be received into a wall (claim 19) or is capable of extending beyond a frame perimeter (claim 21); (2) McManigal is not a window and certainly does not disclose a display that is receivable into a wall (claim 19) or capable of extending beyond a frame perimeter (claim 21); (3) the Examiner concedes that the combination of Mitchell and McManigal does not meet all the limitations of either independent claim 19 or independent claim 21; (4) the Examiner's reliance on "Official Notice" that it is known in

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As seen in the above cross-section, Portwood's vertical stile 3 comprises a unitary resin extrusion have a number of features. Included among these features is a flat cross-web 19 which attaches on the "sash side" to three channel forming webs 26, 27, 28, the latter of which define two sash-receiving channels 29, 30. Attached to the cross-web 19 on the "wall side" are a pair of opposing lips 46 for abutting and forming a seal with the wall in which the frame is installed. The inside lip 46 is connected to the mounting flange 21. A screw 25 secures the mounting flange 21 to the wall W in which the frame 1 is installed, the screw 25 projecting roughly half-way through the thickness of the wall.

McManigal has already been described above, and so its description need not be repeated here.

(1) One of ordinary skill in the art would not modify Portwood as taught by McManigal

The same arguments set forth above with respect to why one having ordinary skill in the art would not modify Mitchell as taught by McManigal apply to why one would not modify Portwood as taught by McManigal.

Most importantly, one can *already* see through the window sashes 9 of Portwood's window frame 1, and so there is no reason whatsoever to have a McManigal-type display (and camera), so that one can see what is on the *other* side of the window sashes 9. It is therefore submitted that the Examiner's alleged motivation for providing Portwood's window frame with a display is without merit and purely comes from hindsight, upon viewing the present invention.

(2) Even if One Were to Modify Portwood as taught by McManigal, One Still Would Not Arrive at the Invention of Independent Claims 19 and 21

The same arguments set forth above with respect to why modifying Mitchell in view of McManigal still would not result in the invention of independent claims 19 and 21, also apply to the Examiner's suggested combination of Portwood and McManigal.

At the outset, it is noted that the Examiner explicitly concedes that the combination of Portwood and McManigal "still fails to teach the window being receivable into the wall adjacent

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the window frame (claim 19) or at least a portion of the window extending beyond the frame perimeter (claim 21).”⁷

Next, as stated above with respect to the Examiner’s rejection based on Mitchell in view of McManigal, the examples supporting the Examiner’s “Official Notice”, i.e., a “vehicle window” and “the door of an elevator” are completely inapposite, and non-analogous art.

Furthermore, the Examiner’s alleged motivation “to provide a full range of opening”⁸ makes little sense in this context, for the same reasons set forth above with respect to the Examiner’s arguments concerning Mitchell in view of McManigal. In any event, Portwood’s horizontally sliding sashes 9 are *already* configured to be moved horizontally and thereby form an “opening”⁹, and so there is no need to make either of the sashes 9 either (a) receivable into the wall adjacent the window frame, or (b) capable of extending beyond the frame.

Lastly, much as in the case with Mitchell, permitting Portwood’s sash window 9 to extend beyond the cross-web 19 into the wall W (see Portwood’s Fig. 5, reproduced above) would render Portwood unsatisfactory for its intended purpose. See MPEP § 2143.01. The whole point of Portwood is to provide an extruded structural member suitable for use in both the horizontal rails 5 and the vertical stiles 3. In this respect, it is noted that Portwood’s claim 1 specifically recites that “each of said stiles and rails being identical in cross section”. To permit Portwood’s horizontally sliding sash 9 to be received into the wall, one must break cross-member 19 (see Portwood’s Fig. 5, reproduced above), which would destroy the extruded stile 3 and make it have a cross-section different from that of the horizontal rails 5. Thus, Portwood teaches away from allowing a sash (or “multi-task” window) to be either (a) receivable into the wall adjacent the window frame (claim 19); or (b) capable of being moved along a horizontal window unit axis until at least a portion of thereof extends beyond the frame perimeter (claim 21). Accordingly, it is submitted that the Examiner’s suggestion for modifying Portwood would destroy the very purpose of Portwood, which is entirely contrary to the admonitions of MPEP § 2143.01.

⁷ March 17, 2006 office action at Page 8, lines 9-11.

⁸ It is also noted that Portwood has a screen 15, which may frustrate any such “opening” if the sashes 9 were moved horizontally out of the way.

⁹ If one were to ignore Portwood’s screen 15.

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To summarize: (1) Portwood's horizontally sliding window sashes 9 are limited by the stile 3 and so neither of them can be received into a wall (claim 19) or is capable of extending beyond a frame perimeter (claim 21); (2) McManigal is not a window and certainly does not disclose a display that is receivable into a wall (claim 19) or capable of extending beyond a frame perimeter (claim 21); (3) the Examiner concedes that the combination of Portwood and McManigal does not meet all the limitations of either independent claim 19 or independent claim 21; (4) the Examiner's reliance on "Official Notice" that it is known in vehicle windows and elevator doors to go beyond a window frame perimeter is irrelevant to the present invention; and (5) modifying Portwood so as to permit either sash to pass through the vertical stile (which would result in the horizontal stiles and vertical stiles no longer being identical), would render Portwood unsatisfactory for its intended purpose, in contravention of MPEP 2143.01.

In view of all of the foregoing, it is submitted that pending claims 19 and 21 are non-obvious over Portwood in view of McManigal, and so should be allowed.

In summary, there is (a) no motivation to combine the prior art in the manner suggested by the Examiner; and (b) even if the primary references (Mitchell and Portwood) were modified by McManigal in the manner suggested by the Examiner, one still would not arrive at the invention of independent claims 19 and 21. Accordingly, it is submitted that claims 19 and 21 define over the combination of references relied upon by the Examiner.

With respect to all claims not specifically mentioned, it is submitted that these are patentable not only by virtue of their dependency on their respective based claims and any intervening claims, but also for the totality of features recited therein.

U.S. Patent No. 4,434,579 to Murphy

The '579 patent is concurrently being submitted in an IDS. During the April 27 interview, the Examiner brought the '579 patent to the attention of the undersigned Attorney for applicants. This patent shows an insulating structure 10 for use with a window 11 carried in a frame 12. The insulating structure comprises a sheet of insulating material 17 and an envelope 13 mounted in an adjacent wall. The sheet of insulating material 17 is slidable in and out of the

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envelope 13 from an inner position (seen in Fig. 1) to an operative position co-extensive with the window 11 and entirely filling the frame 12.

The '579 patent is mentioned here in anticipation that the Examiner may rely on it to establish that the prior art teaches a window assembly comprising a slidable member that is either receivable into the wall adjacent the window frame, or extends beyond the perimeter of a window frame. In other words, the Examiner may argue that independent claims 19 and 21 are obvious in view of Mitchell in combination with McManigal and Murphy (or Portwood in combination with McManigal and Murphy).

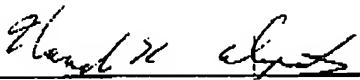
Such a putative rejection, if adopted by the Examiner, is traversed because there is no motivation to make such a combination, and only by hindsight could one 'pick and choose' features from these two combination of references to arrive at the invention recited in the claims.

Reconsideration of the application is requested. For the reasons stated above, it is respectfully requested that the rejection of record be withdrawn with respect to the pending claims 2, 8, 12 and 19-31, and the application be allowed to proceed to issue.

The Commissioner is hereby authorized to charge any additional fees that may be required for the timely consideration of this Amendment under 37 C.F.R. §§ 1.16 and 1.17, or credit any overpayment to Deposit Account No. 09-0528.

Respectfully Submitted,

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